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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,433

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EXAMINER

MAI, HAO D

ART UNIT

PAPER NUMBER

3732

MAIL DATE

DELIVERY MODE

10/27/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,433	<b>Applicant(s)</b> TANIMURA, REMY	
	<b>Examiner</b> HAO D. MAI	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-23 is/are pending in the application.
- 4a) Of the above claim(s) 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/18/2008 has been entered.

### ***Election/Restrictions***

2. Newly submitted claims 21-23 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The new claims 21-23 are directed to a device and/or method involving fixing a transfer part to a dental implant via a hollow intermediate connecting part. These new claims present a patentably distinct species from the originally presented claims. The species would require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to the original species would not likely be applicable to the newly claimed species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Since applicant has received an action on the merits for the originally presented invention/species, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 21-23 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraph of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-2, 13, 16, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Lederer et al. (5,690,639).**

Regarding claim 1-2, Lederer et al. disclose a system and method comprising: reversibly fixing a hollow intermediate part (sleeve 11) onto an external complementary part 15A of tool 10; and thereafter position the tool, which has the hollow intermediate part reversibly fixed thereto, with respect to the end of the implantable element 12 (Figs. 1A-1B); wherein an end 20 of the tool in direct contact with the implant element 12 (Fig. 2). Lederer et al. disclose the sleeve 11 engaging the external part 15A of tool 10, preventing longitudinal movement of the tool relative to the sleeve (Figs. 2-3; column 2 line 66 – column 3 line 12). Sleeve 11 comprises a first clip 19B for fixing itself onto tool 10, and a second clip 19A/21 for clipping or gripping the implant 12 (Fig. 2).

As to claims 13 and 16, sleeve 11 is hollow and includes an opening therethrough parallel to its longitudinal axis; tool 10 is a placing tool for placing the implant 12. As to claims 18-20, note the anti-rotation system (slot 16) being on interior portion of implant 12 (Fig. 2; column 2 lines 58-60); and the anti-rotation system (hexagon 31) on an external portion of implant 12 (Fig. 3; column 3 lines 37-39)

5. **Claims 2-5, 7, 13, and 15-16, are rejected under 35 U.S.C. 102(b) as being anticipated by Gambale (6,328,746 B1).**

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Regarding claim 2, Gambale discloses a system capable of reversible fixing of a tool to an end of an implantable element, when fitting a dental prosthesis, the system comprising: at least one tool 20; at least one implantable element/screw 17; and at least one hollow intermediate connecting part 100 (Fig. 2a-2b). The intermediate connecting part 100 comprises: a first clip 142 capable of reversibly fixing an external complementary part of the tool thereon and preventing longitudinal movement of the tool relative to itself (Figs. 3-4;; column 5 lines 64-67); and a second clip .

As to claims 3-5, the first and second clips each comprises a groove formed in an internal wall of the hollow intermediate connecting part and delimited by rim/annual lips 122, 133 (Figs. 3-4). As to claim 7, the hollow intermediate connecting part 100 is disclosed be made out of plastic (column 3 lines 20-25) and include an opening passing through the surface at both ends for receiving the tool and the implantable element (see annotated Figure below). As to claims 14-16, screw 17 is capable of being a dental implant and screw driver tool 20 is capable of being a placing tool.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 2, and 7-17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gervais et al. (7,160,109 B2).**

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Regarding claim 2, Gervais et al. disclose a system for reversible fixing of a tool to an end of an implantable element, when fitting a dental prosthesis, the system comprising: at least one tool 18; at least one implantable element 16/12; and at least one hollow intermediate connecting part/fixture mount 14 (Fig. 1). The intermediate connecting part 14 comprises: a first clip 15 capable of reversibly fixing an external complementary part of the tool thereon and preventing longitudinal movement of the tool relative to itself; and a second clip 51 clipping the implantable device 16/12 (Fig. 1; column 6 lines 47-50).

However, Gervais et al. fail to disclose the tool being in direct contact with the implantable device. Nevertheless, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gervais et al. by having the tool in direct contact with the implant while they are reversibly fixed together. Such modification is merely a design choice of rearrangement of part (moving the tool further into the hollow connecting part so that the tool in touches the implant) that is well within the skill of an artisan. *MPEP* § 2144.04. Such direct contact between the tool and the implant does not necessarily impart additional torque from the tool to the implant; and thus would not defeat the purpose of the fixture mount to limit the torque applied to the implant.

As to claims 7-12, the hollow intermediate connecting part 14 is further disclosed to be made of plastic and/or metal (column 16 lines 31-34), and comprising paralleling slots/openings 148 allowing the hollow intermediate connecting part 14 to be deformable (Fig. 10; column 3 lines 50-56; column 13 lines 1-10). These slots are shown in alternative embodiments to be T-shaped slots 120 (Fig. 8) or oblique slots 138 (Fig. 9). As to claim 13-14, note the bore/opening 52 parallel to the longitudinal axis (Fig. 6) and the spigots/splines 64 salient towards the inside of the hollow intermediate connecting part 14 (Fig. 2). As to claims 15-17, the implantable element 16/12 is disclosed to be a dental implant 12; the drive tool 18 is capable of placing the

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implantable element; the drive tool 18 is also capable of being a transfer part (column 11 lines 31-34).

### ***Response to Arguments***

8. As to the method claims, Applicant's arguments regarding the method claims 1 and 18-20 have been considered and are moot in view of new ground(s) of rejection under Lederer et al.

As to the apparatus claims, Applicant's arguments regarding Gambale not teaching "a first clip configured...to prevent longitudinal movement of the tool relative to the hollow intermediate connecting part..." are not persuasive. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). Furthermore, it has been held that the recitation that an element is "adapted to" or "configured to" perform a function is not a positive limitation but only requires the ability to so perform. In re Hutchison, 69 USPQ 138. In this case, Gambale discloses all the claimed structural limitations. Particularly, Gambale's first clip 142 is capable of preventing longitudinal movement of the tool relative to the hollow intermediate part as Gambale positively states that "[the cartridge] firmly holds screwdriver 20 within the cartridge" (Figs. 3-4; column 5 lines 64-67). Granted that at insertion, with an applied force the screwdriver tool 20 must move longitudinally relative to the cartridge 100 in order to be inserted therein. Such longitudinal movement also applies to the Applicant's invention.

Applicant's argument regarding Gervais not teaching the newly added limitation "the tool [being] in direct contact with the implantable element" are moot in view of new ground(s) of rejection (see rejection of claim 2 under Gervais above).

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***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAO D. MAI whose telephone number is (571)270-3002. The examiner can normally be reached on Monday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Hao D Mai/  
Examiner, Art Unit 3732**

**/John J Wilson/  
Primary Examiner, Art Unit 3732**